



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE

WASHINGTON, D.C. 20231
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Mailed: MAY 22 2002

Paper No.15

In re Application of	:	
Aprigliano et al.	:	DECISION
Serial No. 09/656,017	:	ON
Filed: September 7, 2000	:	PETITION
For: METHOD OF PRODUCING CORROSION RESISTANT METAL ALLOYS WITH IMPROVED STRENGTH AND DUCTILITY		

This is a decision on the petition filed April 4, 2002, requesting the withdrawal of the finality of the Office action dated February 26, 2002, reopening of prosecution and entry of the proposed Rule 116 amendment filed March 7, 2002.

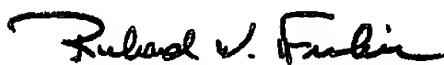
The petitioners argue that the examiner, in the Office action of February 26, 2002, indicating the withdrawal of the finality of the previous Office action mailed November 8, 2001, introduced an issue as to the scope of the claims reflected by the statement that "the scope of the claim does not clearly describe from what strength the strength is increased and under what ductility the ductility is maintained" and the new Office action was again made final.

Subsequent to this final rejection, petitioners filed an amendment under Rule 116, proposing "statements on data which explicitly indicates the extent to which the strength is increased and ductility is maintained".

On March 27,2002, an advisory action was mailed denying entry of the proposed rule 116 amendment as raising a new issue requiring further consideration and/or search.

A review of the record indicates that while the examiner, in the February 26,2002 office action, commented as to why he did not consider the ``increase in strength while maintaing ductility'' language to lend patentability to the claims, this, in fact, did not constitute a new ground of rejection. The purpose of the office action was to clarify the examiner's position relating to issues previously raised by the petitioners as directed by the petition decision of February 11,2002 and the examiner did so. The claims were stated to be rejected for the same reasons as in the previous office action and the rejection did not change. The final rejection was, therefore, proper and the examiner was justified in not entering the Rule 116 amendment of March 7,2002 as raising new issues requiring further search and/or consideration.

The petition is DENIED.



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